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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/667,408	09/21/2000	Charles E. Roos	A32398-PCT-USA-066355.011	8750
21003	7590	01/21/2004	EXAMINER	
BAKER & BOTTS 30 ROCKEFELLER PLAZA NEW YORK, NY 10112			COSIMANO, EDWARD R	
			ART UNIT	PAPER NUMBER
			3629	

DATE MAILED: 01/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/667,408

Applicant(s)

ROOS, CHARLES E.

Examiner

Edward R. Cosimano

Art Unit

3629

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 21 September 2000.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) none is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 September 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

1. Applicant should note the changes to patent practice and procedure:
  - A) effective December 01, 1997 as published in the Federal Register, Vol 62, No. 197, Friday October 10, 1997;
  - B) effective November 07, 2000 as published in the Federal Register, Vol 65, No. 54603, September 08, 2000; and
  - C) Amendment in revised format, Vol. 1267 of the Official Gazette published February 25, 2003.
2. The use of various trademark(s), for example: "Datapump Gateway®" or "Gateway Meter®", at page
  - A) 19, lines 6-18, "The owner of the commercial ... Datapump Gateway®" ... Gateway Meter® ... lines 715 for data distribution and Internet access.",  
has been noted in this application. Any trademarks should be capitalized wherever they appear and be accompanied by the generic terminology.
- 2.1 Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.
3. The drawings are objected to because
  - A) the drawings must show every feature of the invention specified in the claims, therefore, the subject matter of:
    - (1) claim 7 in regard to the "means for detecting a satellite position" and "informing said utility company of a location at the time of an emergency condition."; and
    - (2) claim 14 in regard to "determining whether any breaches in said sealed data port interface have occurred" and the transmitting of data "only if no breaches are detected.";must be shown in the drawings as required by 37 CFR § 1.83(a) or the feature(s) canceled from the claim(s) (note: no new matter should be entered).
  - B) the following errors have been noted in the drawings:

(1) as can be seen in fig. 6 and from the context or the paragraph at page 18, lines 14-22, "Returning to Fig. 6, ... bank 621 refused payment authorization 641.", reference numbers 633 & 634 indicate the wrong feature of the invention.

(2) as can be seen in fig. 6 and from the context or the paragraph at page 18, lines 23-25, "In addition, the bank 621has ... purchase authorization requirements may be imposed 632.", reference number 635 indicates the wrong feature of the invention.

(3) The drawings are objected to as failing to comply with 37 CFR § 1.84(p)(4) because reference character:

(a) "630" has been used to designate both a vendor symbol and decision step in fig. 6, note:

(a)(1) the paragraph at page 18, lines 14-22, "Returning to Fig. 6, ... vendor 630 ... vendor 630 ... bank 621 refused payment authorization 641.";

(a)(2) the context or the paragraph at page 18, lines 23-25, "In addition, the bank 621has ... U.S. laws 630 ... purchase authorization requirements may be imposed 632."; and

(a)(3) the paragraph at page 18, lines 26-29, "Only when all safeties ... vendor 6301 ... with potentially troublesome vendors.".

(4) The drawings are objected to as failing to comply with 37 CFR § 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description:

(a) "6301" as disclosed in the paragraph at page 18, lines 26-29, "Only when all safeties ... vendor 6301 ... with potentially troublesome vendors.".

3.1 A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

3.2 Applicant is required to submit a proposed drawing correction in reply to this Office action. However, formal correction of the noted defect may be deferred until after the examiner has considered the proposed drawing correction. Failure to timely submit the proposed drawing correction will result in the abandonment of the application.

4. The disclosure is objected to because of the following informalities:

A) applicant must update:

(1) the continuing data on page 1,  
with the current status of each of the referenced applications, e.g., --now abandoned--,  
or --now patent #?--, or --which is abandoned and now serial number #?--, etc.

B) as required by 37 CFR § 1.84(p(5)) and 37 CFR § 1.121(e) the specification  
lacks an explicit reference to the nature of:

(1) reference legend(s):

(a) 518 of figs. 5a-5e as figure 5a is described in the paragraph at  
page 17, lines 15-19, "Figs. 5a-5e illustrate ... stress relief 567 and cable  
565."; and

(b) 560 of figs. 5c & 5d as these figures are described in the  
paragraph at page 17, lines 20-24, "In Fig. 5b, the utility interface ...  
port 570 is located inside of the meter box 514."; and

(2) how the program proceeds after box(es):

(a) 635 of fig. 6 if the inquiry is "YES" in the context or the  
paragraphs at page 18, lines 23-29, "In addition, the bank 621has ...  
with potentially troublesome vendors."; and

(b) 630 of fig. 6 if the inquiry is "NO" in the context or the  
paragraphs at page 18, lines 23-29, "In addition, the bank 621has ...  
with potentially troublesome vendors.".

In this regard, it is noted that merely mentioning either a feature or a number with out mentioning the device or operation or number or feature relies on the drawing to provide support for the disclosure and not to aid in the understanding of the invention, as is the purpose of the drawings (37 CFR § 1.81(a,b)).

C) the following errors have been noted in the specification:

(1) as can be seen in fig. 5a and from the context of the paragraph at page 17, lines 15-19, "Figs. 5a-5e illustrate ... meter seal rings 418. The ... stress relief 567 and cable 565.", at line 4 of this paragraph "418" should be - 518--.

(2) at line 1 of the paragraph at page 18, lines 23-25, "In addition, the bank 621has ... purchase authorization requirements may be imposed 632.", "621has" should be -621 has--.

(3) at line 2 of the paragraph at page 18, lines 26-29, "Only when all safeties ... vendor 6301 ... with potentially troublesome vendors.", should "6301" be -630--? Note also above in regard to the use of reference number 630 twice in fig. 6 and the description of fig. 6.

D) the subject matter of:

(1) claim 7 in regard to the "means for detecting a satellite position" and "informing said utility company of a location at the time of an emergency condition."; and

(2) claim 14 in regard to "determining whether any breaches in said sealed data port interface have occurred" and the transmitting of data "only if no breaches are detected.";

lacks antecedent basis within the specification as required by 37 CFR § 1.75(d1).

Appropriate correction is required.

5. The specification and drawings have not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification or drawings.

Applicant should note the requirements of 37 CFR § 1.74, § 1.75, § 1.84(o,p(5)), § 1.121(a)-1.121(f) & § 1.121(h)-1.121(i).

6. Claims 7 & 14-17 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

6.1 The subject matter of:

A) claim 7 in regard to the "means for detecting a satellite position" and "informing said utility company of a location at the time of an emergency condition."; and

B) claim 14 in regard to "determining whether any breaches in said sealed data port interface have occurred" and the transmitting of data "only if no breaches are detected.";

lacks antecedent basis within the specification as required by 37 CFR § 1.75(d1).

6.2 Claims not specifically mentioned above, inherit the defects of the base claim through dependency. For the above reason, applicant has failed to particularly point out what is regarded as the invention.

7. Claims 1-17 are rejected under the judicially created doctrine of double patenting over claims 1-37 of U. S. Patent No. 5,699,276 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

7.1 The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows:

A) an utility meter unit; and

B) a computerized interface device for providing the exchange of data, video, voice/sound between an internal network and an external network.

7.2 The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29

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USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

7.3 A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

7.4 Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002



do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

8.1 Claims 1-10 are rejected under 35 U.S.C. § 102(e) as being clearly anticipated by Davis et al (5,898,387).

8.1.1 In regard to claims 1-10, Davis et al ('387) discloses a meter box that includes an utility meter for measuring the amount of a utility consumed by a house and an area to accept various network interface cards. Where the network interface cards permit an external network to communicate with a network that internal to the house.

8.2 Claims 11-13 are rejected under 35 U.S.C. § 102(e) as being clearly anticipated by either Davis et al (5,898,387) or Jarman et al (2003/0167178).

8.2.1 In regard to claims 11-17 and the use of the claimed interface to perform secured transactions over the network, since this feature was first introduced in the instant application the effect date for claims 11-17 is 21 September 2000.

8.2.2 Further, in regard to claims 11-13, first it is noted that the secured transaction of claim 11 is deem to be non-functional descriptive material, since this features does not alter or change how the remaining claimed features operate. Nonfunctional descriptive material cannot render nonobvious an invention that would have otherwise been obvious. Cf. In re Gulack, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983) (when descriptive material is not functionally related to the substrate, the descriptive material will not distinguish the invention from the prior art in terms of patentability). Common situations involving nonfunctional descriptive material are:

- a computer that differs from the prior art solely with respect to nonfunctional descriptive material that cannot alter how the machine functions (i.e., the descriptive material does not reconfigure the computer), or
- a process that differs from the prior art only with respect to nonfunctional descriptive material that cannot alter how the process steps are to be performed to achieve the utility of the invention.

8.2.3 Further, in regard to claims 11-17, since it is well known and common practice in the environment of communication between various devices in a network to:

A) assign an unique address/identification to each of the networked devices so as to avoid any confusion between various networked devices as to whether or not a message is intended for a particular device;

B) to use a common communications protocol so that each device on the network may properly interpret an communication between the networked devices;

C) to verify the proper device has properly received the message;

one of ordinary skill at the time the invention was made would have recognized that the system of either Davis et al ('387) or Jarman et al ('178) would use unique addresses and verify that the correct device has in fact received the transmitted message.

8.2.4 Now in regard to claims 11-13, either Davis et al ('387) or Jarman et al ('178) disclose a meter box that includes an utility meter for measuring the amount of a utility consumed by a house and an area to accept a network interface card. Where the network interface card permits an external network to communicate with a network that internal to the house. And where Davis et al ('387) accepts a number of different network interface cards.

8.2.5 Now in regard to claims 12 & 13, Jarman et al ('178) further permits payment transactions to occur via the interface. As is common practice, if there are insufficient funds for such a payment transaction, then the transaction would be denied.

9. The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

(c) Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability

under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

9.1 Claims 14-17 are rejected under 35 U.S.C. § 103(a) as being unpatentable over either Davis et al (5,898,387) or Jarman et al (2003/0167178) as applied to claims 11-13 and further in view of common practice.

9.1.1 In regard to claims 11-17 note above in sections 8.2.1 through 8.2.3, and further noted that it is well known and common practice for most computer devices perform a self check for the purpose of preventing errors.

9.1.2 Now in regard to claims 14-17, either Davis et al ('387) or Jarman et al ('178) disclose a meter box that includes an utility meter for measuring the amount of a utility consumed by a house and an area to accept a computerized network interface card. Where the network interface card permits an external network to communicate with a network that internal to the house. And where Davis et al ('387) accepts a number of different network interface cards and where Jarman et al ('178) further permits payment transactions to occur via the interface. As is common practice, if there are insufficient funds for such a payment transaction, then the transaction would be denied.

9.1.3 Since a problem with the computer networks of either Davis et al ('387) or Jarman et al ('178) could potentially cause problems with any of the functions associated with the operation of the network, it would have been obvious tone of ordinary skill at the time the invention was made that the systems of either Davis et al ('387) or Jarman et al ('178) would perform as self check and prevent future operation of the system if an error has been detected.

10. The examiner has cited prior art of interest, for example:

A) either Cavanaugh or Karny et al (2002/0145509), which disclose an utility meter being connected through an interface to a communications network for the purpose of exchanging various types of information with a remote utility computer and a internal house network of devices. Further Karny et al ('509) permits payment transactions to occur via the interface.

B) either Ehlers et al (5,572,438) or Loy et al (5,940,009) which disclose an utility meter being connected through an interface to a communications network for the purpose of exchanging various types of information, such as power measurements and detected tampering with a remote utility computer.

11. The shorten statutory period of response is set to expire 3 (three) months from the mailing date of this Office action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Edward Cosimano whose telephone number is (703) 305-9783. The examiner can normally be reached Monday through Thursday from 7:30am to 6:00pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss, can be reached on (703)-308-2702. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1113.

12.1 The fax phone number for UNOFFICIAL/DRAFT FAXES is (703) 746-7240.

12.2 The fax phone number for OFFICIAL FAXES is (703) 872-9306.

12.3 The fax phone number for AFTER FINAL FAXES is (703) 872-9306.

01/09/03



**Edward R. Cosimano**  
**Primary Examiner A.U. 3629**